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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|------------------------------|---------------------|------------------|
| 10/552,315 | 10/07/2005 | Valentina Ivanovna Akhapkina | V-322 | 6642 |
| 802 | 7590 | 08/03/2007 | | |
| PATENTTM.US | | | EXAMINER | |
| P. O. BOX 82788 | | | KIM, JENNIFER M | |
| PORTLAND, OR 97282-0788 | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |
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| | | | 08/03/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/552,315 | AKHAPKINA ET AL. | |
| | Examiner | Art Unit | |
| | Jennifer Kim | 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed June 20, 2007 has been received and entered into the application.

Action Summary

The objection to the abstract because of the employment of legal phraseology and objection to the claim due to the claim not being numbered in the previous Office Action is hereby expressly withdrawn in view of Applicants' amendment.

The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by INSTITUT MEDIKO-BIOLOGICHESKIKH PROBLEM (RU 205051) is being maintained for the reasons stated in the previous Office Action. However, the rejection is modified in this Office Action to address the amended claim limitation.

The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Applicants' admission is being maintained for the reasons stated in the previous Office Action. However, the rejection is modified in this Office Action to address the amended claim limitation.

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The following objection has been made in view of Applicants' amendment to the abstract:

Objection

The amendment filed June 20, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: terms and phrases "wilderness", "disaster" and "neurodynia", "trade names: Phenotropil, Karfedon", "anticonvulsant activity", and ". . . .widens the armoury. . . .".

Applicants are required to cancel the new matter in the reply to this Office Action.

The Examiner notes that Applicants' amendment to the abstract filed June 20, 2007 does not follow the rules under 37 CFR 1.121, see MPEP 714. Applicants have not indicated all the deletions and insertions. (see above objection to new matter).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by INSTITUT MEDIKO-BIOLOGICHESKIKH PROBLEM et al. (RU 205051) of record.

INSTITUT MEDIKO-BIOLOGICHESKIKH PROBLEM teaches the use of N-carbamoylmethyl-4-phenyl-2-pyrrolidone (carphedon, also known as phenotropyl) as an agent with nootropic activity. (see also international search report).

The limitation of “a substance **displaying antidepressant activity**” is noted. However, where the claimed invention is a chemical compound, the “compound and all of its properties are inseparable; they are one and the same thing”. In re Papesch, 315, F2d 381, 391 (C.C.P.A. 1963). In this case, the same active substance is taught by the reference. Therefore, the same active substance taught by the reference would inherently have the properties of displaying antidepressant activity. The reference clearly anticipates the claimed substance. It discusses the same chemical compound. It must possess the same properties as claimed because it is one and the same compound.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Applicants' admission.

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Applicants admit that phenotropyl (also known as N-carbamoylmethyl-4-phenyl-2-pyrrolidone) is known as a substance having nootropic activity taught in RU2050851. (see specification page 2, lines 9-12).

The limitation of “a substance **displaying antidepressant activity**” is noted. However, where the claimed invention is a chemical compound, the “compound and all of its properties are inseparable; they are one and the same thing”. In re Papesch, 315, F2d 381, 391 (C.C.P.A. 1963). In this case, the same active substance is taught by the reference. Therefore, the same active substance taught by the reference would inherently have the properties of displaying antidepressant activity. The reference clearly anticipates the claimed substance because it discloses the same chemical compound with properties inseparable as claimed from that compound.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 102(b).

None of the claims are allowed.

Response to Arguments

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Applicants' arguments filed June 27, 2007 have been fully considered but they are not persuasive. Applicants argue that claim 1 is amended to correct the typographical error to recited "antidepressant" rather than "nootropic" and the art relied on neither teaches nor suggests amended claim 1. This is not found persuasive because Applicants' active substance recited in claim 1 is a well known compound as clearly taught by INSTITUT MEDIKO-BIOLOGICHESKIKH PROBLEM (RU 205051). Applicants also admit that the claimed substance, phenotropyl (N-carbamoylmethyl-4-phenyl-2-pyrrolidone) is known as a substance having nootropic activity taught in RU2050851. Therefore, Applicants' claimed limitation is an inherent property of the same compound taught by the prior art because the substances which are identical chemical compounds cannot have mutually exclusive properties.

Therefore, the claimed invention is clearly anticipated by the cited references.

Communication

The use of a trade name has been noted in this application (e.g. Varimax, page 6 of specification) but neglect to use the registration symbol. To make it clear that Applicants are reciting a trademark, the registration symbol should be added to all use of trade names. However, such corrections can be made at the time of allowance if this case should be allowed.

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THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jennifer Kim
Patent Examiner
Art Unit 1617

Jmk
July 28, 2007